REMARKS

Claims 36, 38-40, 42-44, 46-48, 50-56 and 58-61 are pending in this application.

Claims 36, 42, 43, 44, 50, 51, 52, 58, 59 and 60 are independent.

The claim of priority to 1991 is denied. The denial is respectfully traversed.

The present Application is a Continuation of United States Patent Application Serial Number 09/250,675, now abandoned, which is a Continuation of United States Patent Application Serial Number 08/372,620, now United States Patent Number 5,873,072, which is a Continuation of United States Patent Application Serial Number 07/736,071, now United States Patent Number 5,383,113.

The Examiner contends that two way data flow between details 22 and 24 of Figure 2 of the '072 Patent is not supported by the original disclosure of the '113 Patent. It is respectfully submitted that the Examiner is mistaken.

Figure 2 of the '113 Patent is reproduced as Figure 1 in the '072 Patent. In Figure 2 of the '113 Patent, detail 22, the consumer database, and detail 24, the FIF file, are linked by a unidirectional arrow flowing from the FIF file to the consumer database. In Figure 1 of the '072 Patent the consumer database and the FIF file are linked by a bi-directional arrow.

A unidirectional arrow generally denotes a one-way flow, and a bi-directional arrow generally denotes a two-way flow. Both the '113 Patent and the '072 Patent disclose two-way flow between the FIF file and the consumer database, even though Figure 2 of the '113 Patent only depicts a unidirectional arrow. In particular, column 2, line 65, through column 3, line 14, of the '113 Patent and column 3, lines 7-20, of the

2

'072 Patent each teach that bank routing transit and individual account numbers are input into a computer system and that this information can be edited against the FIF file 24, which is a part of the computer system.

The information in the FIF 24 that is used for editing "may be obtained from each banking institution and each consumer", as recited at column 3, lines 12-14, of the '113 Patent and at column 3, lines 19-20, of the '072 Patent. Thus, information received from consumers is passed to the FIF for storage, and information stored in the FIF is retrieved edit received financial institution information.

Accordingly, both the '113 Patent and the '072 Patent teach a flow of information into and out of the FIF. Therefore, the inclusion of a bi-directional arrow in Figure 1 of the '072 Patent does not constitute new matter.

The Examiner also draws attention to a link between details 32 and 36 of Figure 2 of the '072 Patent, contending that the '113 Patent and the '072 Patent each do not provide support for the link. It is respectfully submitted that the Examiner is mistaken.

Part of Figure 3 of the '113 Patent is reproduced as Figure 2 of the '072 patent, and part of Figure 3 of the '113 Patent is reproduced as Figure 3 of the '072 Patent. Detail 32, which represents information identifying a merchant, and detail 36, which represents a payment request, are reproduced in Figure 2 of the '072 Patent. Figure 2 of the '072 Patent includes the link connecting details 32 and 36, wherein Figure 3 of the '113 Patent does not include this link.

Both Figure 3 of the '113 Patent and Figure 2 of the '072 Patent show, by arrows, a payment request and information identifying a merchant flowing from a consumer to

3

the service provider. The link of Figure 2 of the '072 Patent does not include arrow ends. As such, it does not denote any information flow. Rather, it shows an association between a payment request and information identifying a merchant.

The Examiner argues that the link of Figure 2 of the '072 Patent shows "a new interface element of interaction" between details 32 and 36, namely adding a merchant via a payment request. As will be discussed below, this processing is disclosed in the '113 Patent as well as the '072 Patent, especially when taken in light of the fact that the specification of the as-filed '620 Application does not include any new matter, as shown in the Appendix included herewith. Inclusion of the link between details 32 and 36 does not constitute new matter, rather it merely illustrates an aspect of the invention disclosed in both the '113 Patent and the '072 Patent, namely, the functionality to add a merchant through a payment request.

The Examiner also points to Figure 3 of the '072 Patent as including matter not disclosed in the '113 Patent. Again, it is respectfully submitted that the Examiner is mistaken.

Figure 3 of the '072 Patent includes an unnumbered box labeled "rejects". This unnumbered box does not appear in Figure 3 of the '113 Patent. The text of the '113 Patent and the text of the '072 Patent disclose rejecting information received at the front end processor. In particular, attention is drawn to column 4, lines 43-46, of the '113 Patent and column 4, lines 33-36, of the '072 Patent. This text recites: "The payment [received via the front end processor] may first go through a validation process against the pay table. The validation process checks for duplicate payments and if duplicates

are found they are sent to a reject file." Thus, inclusion of the unnumbered box labeled "rejects" does not constitute new matter, rather it merely illustrates an aspect of the invention disclosed in both the '113 Patent and the '072 Patent, namely, rejecting duplicate payment requests.

The Examiner also points to column 4, lines 26-21, of the '072 patent as excluding disclosure found at column 4, lines 37-41 of the '113 Patent. The Examiner contends that Applicants are attempting to broaden the scope of the invention as disclosed in the '113 Patent by the exclusion of this language. It is respectfully submitted that the Examiner is again mistaken.

The '113 Patent recites: "New merchants are compared to the MMF 42 and appropriately cross-referenced by the software of the present invention to the pay table to check if a merchant record already exists. If no merchant record exists, a merchant record will be created on the MMF 42". The '072 Patent recites: "New merchants are compared to the MMF 42 and appropriately cross-referenced to the pay table to check if a merchant record already exists. If no merchant record exists, a merchant record will be created on the MMF 42". Thus, "by the software of the present invention" does not appear in the '072 Patent.

As seen in both the '113 Patent and the '072 Patent, one implementation of the disclosed invention is achieved by the use of software. Both the '113 Patent and the '072 Patent are replete with references to the software of the present invention. The '113 Patent and the '072 Patent each disclose the operations of comparing new merchants to the MMF 42 and adding new merchants to the MMF 42 if a merchant

record does not exist, can be achieved by the use of software. It would be understood by one of ordinary skill in the art that the disclosed operations could be achieved by the use of the software disclosed throughout both the '113 Patent and the '072 Patent. Exclusion of the phrase "by the software of the present invention" from the '072 Patent does not in any way substantially alter the disclosure in the '113 Patent.

Also, the '620 Continuation Application, from which the '072 Patent matured, includes an incorporation-by-reference statement specifically incorporating the entirety of the '113 Patent. Thus, the instance of "software" recited in the '113 patent, but not the '072 Patent, is incorporated into the '072 Patent by reference. Therefore, for this reason also, the exclusion of the phrase "by the software of the present invention" from the '072 Patent does not in any way alter the scope of that disclosed in the '113 Patent.

As should be clear from the above, the '072 Patent does not include new matter not found in the '113 Patent. The scope of that disclosed in the '113 Patent is the same as the scope of the invention claimed in the '072 Patent. As such, each claim limitation in the present Application is expressly supported by the disclosure of the '113 Patent. Accordingly, priority of the present application to the filing date of the '113 Patent, i.e. July 25, 1991, should be granted and used in applying prior art to the claims of the instant application. Therefore, it is respectfully requested that the Examiner reconsider and withdraw the denial of priority.

In addition to the differences between the '113 Patent and the '072 Patent noted by the Examiner, other differences also exist. In the Appendix included herein is a discussion of each of the differences in certain sections of these patents, evidencing

that none, including the ones noted by the Examiner, constitute an insertion of new matter into the disclosure of the '113 patent.

Accordingly, it is respectfully requested that the denial of the claim of priority to 1991 be reconsidered and withdrawn.

Claims 36, 38-40, and 42 stand rejected under 35 USC §101, as directed to non-statutory subject matter. The rejection is respectfully traversed.

As discussed in In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994):

> "the dispositive issue for assessing compliance with Section 101 in this case is whether the claim is for a process that goes beyond simply manipulating 'abstract idea' or 'natural phenomena......' As the Supreme Court has made clear '[a]n idea of itself is not patentable,.....taking several abstract ideas and manipulating them together adds nothing to the basic equation.' In re Warmerdam, 31 USPQ 2d at 1759.

Further guidance on this issue is provided by AT&T Corp. v. Excel Communications, Inc., 50 USPQ 2d 1447 (Fed. Cir 1999). In AT&T v. Excel, the Court discussed the above quoted language from In re Warmerdam, and concluded that:

> "[w]hether one agrees with the court's conclusion on the facts, the holding of the case is a straightforward application of the basic principal that mere laws of nature, natural phenomena, and abstract ideas are used within the categories of inventions or discoveries that may be patented under § 101." AT&T v. Excel, at 1453.

Perhaps more relevant to the present case is the statement of the Court in AT&T v. Excel, quoting from its opinion in State Street Bank and Trust Co. v. Signature Financial Group, Inc., 47 USPQ 2d 1596 (Fed. Cir. 1998), that:

> "the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it non-

stationary subject matter, unless, of course, its operation does not produce a useful, concrete and tangible result. "AT&T v. Excel, at 1453.

The burden is on the Office personnel "to establish a prima facie case that the claimed invention taken as a whole is directed to the manipulation of abstract ideas without a practical application." The MPEP states that:

> "Office personnel must analyze the claim as a whole, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. During this procedure Office personnel must evaluate any statements of intended use or field of use, any data gathering step and any post-manipulation activity....Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101. Further when such a rejection is made, Office personnel must expressly state how the language of the claims has been able to support the rejection."

MPEP 2106, Section IV.B.2(b)(ii), cautions that a claimed process, which is limited to a practical application of an abstract idea or mathematical algorithm in the technological arts, is statutory subject matter. As an example, it is specifically noted that a process for digitally filtering noise employing a mathematical algorithm is statutory. As further noted in the MPEP, a claimed process which recites a step or act of producing a concrete, tangible and useful result is limited to a practical application, and thus directed to statutory subject matter.

Claim 36, on which claims 38-40 depend, recites a method for processing consumer banking information which includes (i) storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, (ii) receiving a routing number associated with a financial institution at which a consumer

maintains a deposit account, and (iii) comparing the received routing number to the stored plurality of routing numbers in the financial institutions file <u>to verify accuracy of the received routing number</u> (emphasis added).

The Examiner asserts in the Final Official Action, that claim 36, and its dependent claims 38-40, recite "merely abstract ideas that are not within the technological arts".

However, contrary to the Examiner's assertion, these claims explicitly require a process in which the accuracy of a received routing number is verified. More particularly, the comparison step of parent claim 36 limits the claimed invention to a practical application (see MPEP 2106). The invention, as recited, produces a useful, concrete and tangible result (i.e. a verification of the accuracy of the received routing number). Thus, Applicants are seeking a patent on an invention which is much more than just an abstract idea, and which clearly falls within the mandates of 35 USC §101.

Furthermore, it is respectfully submitted that dependent claims 38-40 also further limit the claimed invention to a practical application. For example, claim 40 requires that it be determined if the consumer financial institution accepts electronic fund transfers based on the verified routing number, and if so, that an instruction to pay the bill by electronic fund transfer from the consumer deposit account be generated. Thus, the claimed invention produces a further useful, concrete and tangible result (i.e. an instruction to pay a bill by an electronic fund transfer).

Claim 42 recites features similar to those required by claim 40. Here also, the Examiner asserts in the final Official Action that claim 42 recites "merely abstract ideas

that are not within the technological arts". However, for the reasons detailed above, the invention of claim 42 also produces useful, concrete and tangible results (i.e. both a verification of the accuracy of the received routing number and an instruction to pay by electronic fund transfer), and accordingly is limited to a practical application.

Further still, the recited verification and/or generation of a payment instruction, in and of themselves, are post-manipulation activity. Additionally, as described in the specification, the usefulness of the recited method in, for example, providing electronic bill payment services, will be well understood by those skilled in the art.

It is perhaps also worthwhile noting that there is no requirement, either within 35 U.S.C. 101 or the case law, that a process must be performed via a computer, network or other electronic communications means in order to be patentable, as the Examiner seems to suggest.

It is therefore respectfully submitted that each of the rejected claims are clearly limited to a practical application, and are therefore directed to more than just the manipulation of abstract ideas. Thus, it is respectfully requested that the Examiner reconsider and withdraw the 35 U.S.C. § 101 rejection of claims 36, 38-40 and 42.

Claims 36, 38 and 39 stand rejected under 35 USC §103(a), as obvious over Braum, et. al. (U.S. Patent No. 4,321,672) in view of Jan Paschal article entitled "NEW EDITION OF RAND MCNALLY BANKERS DIRECTORY AVAILABLE". Claims 40, 42-44, 46-48, 50-56 and 58-61 stands rejected under 35 USC §103(a), as obvious over the base combination, in further view of Lawlor (U.S. Patent No. 5,220,501) and Case (U.S. Patent No. 4,270,042. The rejections are respectfully traversed.

As described by Braum in the Examiner referenced text in columns 11 and 12, a user enters an MICR encoded account number (which includes a routing number) at an ATM machine. This information is then routed to the user's financial institution. The routing number is checked against stored information representing account numbers for accounts at that financial institution, to verify the received routing number. Hence, as acknowledged by the Examiner, Braum fails to disclose (i) the required storage of a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) the required comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number.

To overcome this deficiency, the Examiner proposes to modify Braum to include the required financial institutions file and to perform the comparison of a received routing number with the routing numbers stored in such a file in order to verify the accuracy of the received routing number, based on Paschal's disclosure of a directory of active and retired bank routing numbers published by Rand McNally.

The Examiner asserts that it would have been obvious to modify Braum to include such a routing number directory and to compare a routing number entered at an ATM with the routing numbers in such a directory to verify the accuracy of the received routing number. The Examiner further asserts that this modification is motivated because it "would help to store the common data like routing numbers together for all financial institutions in one place and to include the updated information on the active and retired routing numbers so that any routing number received can be verified if it is

active or retired or incorrect routing number".

It is respectfully submitted that, contrary to the Examiner's contentions, there is no motivation to combine the references as proposed.

First, as noted in the applied Paschal publication, Rand McNally has published the ABA routing number directory since 1911. Accordingly, Braum was presumably aware of the availability of the directory at the time of his application for patent in 1979, and yet concluded there was no advantage to utilizing this directory (or a corresponding financial institutions file) in the described system. Hence, Braum's own disclosure evidences that experts in the art, without the benefit of the disclosure set forth in the present application, failed to recognize the benefits of utilizing a financial institutions file storing a plurality of routing numbers associated with a plurality of financial institutions (e.g. a file corresponding to the Rand McNally directory or routing numbers) for routing number verification.

Furthermore, Braum has no need for a file corresponding to the Rand McNally directory. More particularly, Braum directs the routing numbers furnished by a customer to the customer's financial institution for verification. Hence, having each customer's own financial institution utilize the Rand McNally directory (or a corresponding file) would result in unnecessary information being stored and searched at each financial institution. This in turn would needlessly add additional expense and time to the processing being performed at each financial institute, which is inconsistent with Braum's objectives of reducing processing expense and time, and making the processing more efficient. Indeed, modifying Braum as proposed by the Examiner,

would simply result in additional expense, time and inefficiency without any corresponding benefit.

Furthermore, there is nothing in either of the applied art references to suggest the proposed combination, and the Examiner has failed to cite any disclosure with either of the base references which make such a suggestion. Although the Examiner states that it would be obvious to use the Rand McNally directory to verify the accuracy of a received routing number, the applied art itself teaches against the use of such a directory for such a purpose.

Further still, the Examiner baldly alleges that using such a directory would be beneficial because it would store routing numbers for different financial institutions which could be used to verify a received routing number in one place. However, one can only ask why this would be beneficial in view of Braum's requirement that the verification of a routing number be performed by the financial institution to which that routing number relates. As noted above, based on the explicit teachings of Braum, the Examiner's proposed modification would result in unnecessary information being stored and compared with a received routing number, thereby making the Braum system less efficient, and its processing more time consuming and costly, contrary to Braun's objectives.

Since the prior art does not support the Examiner's conclusion, it would appear that the Examiner has reached these conclusions using the present application disclosure as a roadmap. Thus, it would appear that the rejection is based on an improper hindsight reconstruction of the invention.

Accordingly, it is respectfully requested that the rejection of the claims be reconsidered and withdrawn.

With regard to claim 40, the Examiner acknowledges that the base combination fails to disclose the required (i) receiving of a request to pay a bill associated with a merchant on behalf of a consumer, (ii) determining if the consumer financial institute accepts electronic fund transfers based on the verified routing number and (iii) generating of an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers (EFT). The Examiner therefore proposes to modify the base combination in view of the teachings of Lawlor and Case to cure this deficiency.

The Examiner asserts that it would have been obvious to those skilled in the art to modify the base combination "to combine the features of Lawlor of receiving requests to pay a bill with a merchant on behalf of the consumer via an ATM network and generate payment instructions via electronic funds transfer if feasible." According to the Examiner, "[d]oing so would benefit consumers to implement bill payments electronically from home and benefit payees by cutting down their processing costs, float, offering more predictable cash flow as explicitly disclosed by Lawlor".

In this regard, the Examiner asserts that Lawlor teaches that a determination is made as to whether or not the consumer financial institution accepts electronic fund transfers (citing column 10, line 66, through column 11, line 65).

However, contrary to the Examiner's assertion, as disclosed in the Examiner referenced text in column 11, Lawlor teaches that the consumer's financial institute

14

always accepts electronic fund transfers (via ATM). Hence, Lawlor has no need for, and lacks any disclosure of, a determination of whether or not the consumer financial institution accepts EFT (see column 11, lines 43-55).

Furthermore, although the Examiner asserts that Case teaches a determination as to whether or not the consumer's financial institution accepts electronic fund transfers, based on a verified routing number (citing column 4, line 61, through column 5, line 2), this is not the case. According to Case, the account holder punches element 37 if EFT is desired. It should be noted that Case also discloses that in block 57 of the card shown in Figure 3 contains the ABA routing number. However, Case fails to disclose any verification of this routing number or utilization thereof for determining if the account holder's financial institution accepts electronic fund transfers.

Hence, the rejection has been based on a misunderstanding of what is disclosed by Lawlor and Case. Accordingly, it is respectfully requested that the rejection of claim 40 also be reconsidered and withdrawn on this basis.

As claims 42-44, 46-48, 50-56, and 58-61 stand rejected on the same basis as the claims discussed above, it is respectfully requested that the rejection of these claims also be reconsidered and withdrawn for the foregoing reasons.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further
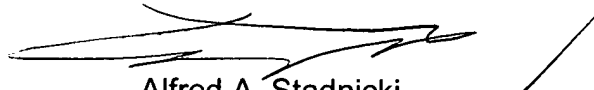
comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

Alfred A. Stadnicki
Registration No. 30,226

20457
PATENT TRADEMARK OFFICE

AAS/led
1300 N. 17th Street
Suite 1800
Arlington, Virginia 22209
Telephone: 703-236-6080
Facsimile: 202-296-1682
DATE: April 30, 2003
Enclosures: Appendix and Exhibits A-S